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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,446	02/20/2002	James M. Clauss	109859-130053	3040

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EXAMINER

BADERMAN, SCOTT T

ART UNIT	PAPER NUMBER
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2113

DATE MAILED: 07/06/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/081,446

Applicant(s)

CLAUSS ET AL.

Examiner

Scott T Baderman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-67 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 64-67 is/are allowed.
6) ☒ Claim(s) 16-50, 52-56 and 58-62 is/are rejected.
7) ☒ Claim(s) 51, 57 and 63 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. Claims 64-67 are allowed.
2. The following is an examiner's statement of reasons for allowance:

With respect to claims 64 and 66, the Examiner asserts that the novelty of the claims, when read as a whole, is "adding information to the error/warning message stored in the error/warning storage structure, the information reported from a second function that called the first function."

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Claims 51, 57 and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 46-50, 52-56 and 58-62 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5, 6-10 and 11-15, respectively, of prior U.S. Patent No. 6,363,503.

This is a double patenting rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As in claim 16, the term "etc." (line 2) deems the claim indefinite since the scope of the claim can not be determined.

Regarding claims 17-25, they depend from rejected claim 16.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16-23, 26-33 and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (6,397,117) in view of Ben-Natan et al. (5,740,354).

As in claims 16, 26 and 36, Burrows discloses a computer-implemented method and system for manipulating a computer design of operation by a computer aided design (CAD) application that comprises receiving a user input to perform an operation on a CAD design and generating a failure indication (error message) upon detecting a failure during performance of the operation (Figure 3, Abstract, column 1: lines 11-14, column 4: lines 50-61) (Although Burrows does not specifically disclose detecting a failure, it is implied since during the operation, an analysis is performed and the results are returned to the user, wherein the results can include an error message). However, Burrows does not clearly disclose providing information to the user to facilitate the user in determining a location of a cause of the failure within the CAD design and information about how to recover from the failure. Ben-Natan discloses a method for error

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handling, wherein an error message that is returned as a result of a failure includes information to facilitate a user in determining a location of a cause of the failure and information about how to recover from the failure (Figures 9-12, column 1: lines 5-66).

It would have been obvious to a person skilled in the art at the time the invention was made to include providing information to the user to facilitate the user in determining a location of a cause of the failure within the CAD design and information about how to recover from the failure into the method and system taught by Burrows above. This would have been obvious because both Burrows and Ben-Natan teach of generating error messages, wherein Ben-Natan further teaches that it is beneficial to supply error messages that are meaningful to a user so that they will be useful in understanding and aid the user to remediate the error (column 1: lines 5-66).

As in claims 17, 27 and 37, Burrows (column 1: lines 11-14) and Ben-Natan (column 1: lines 55-66) disclose detecting an occurrence of one or more software events that are to result in at least one of an error.

As in claims 18, 28 and 38, Ben-Natan discloses generating and displaying a user interface having a title indicative of the operation (e.g., "Could not open expenses.xls") during which operation, the failure was encountered (Figures 9-12, column 1: lines 55-66).

As in claims 19, 29 and 39, Ben-Natan discloses generating and displaying one or more expandable error messages (i.e., when a user selects a displayed error report, all of the error

reports relating to the same error as the selected error report are displayed (expanded) together) (column 14: lines 2-5).

As in claims 20, 30 and 40, Ben-Natan discloses generating and displaying one or more error messages in a hierarchical manner (column 13: line 60 – column 14: line 11).

As in claims 21, 31 and 41, Ban-Natan discloses facilitating receiving an indication of at least one of editing, canceling and accepting the failure (i.e., since the user can remediate the error using the error message, it must have accepted the failure (column 1: lines 55-66).

As in claims 22, 32 and 42, Ben-Natan discloses generating and displaying a message having a suggestion for solving the failure (i.e., meaningful error messages provide a suggestion as to what to do next) (Figures 9-12, column 1: lines 55-66).

As in claims 23, 33 and 43, Burrows discloses that after performing an analysis, the results are returned to the user either in the form of textual or graphical information, or as a file representing a completed design, which suggests that the results visually indicate a portion of the CAD design associated with a failure, if one is detected (column 4: lines 50-61).

10. Claims 24, 25, 34, 35, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. and Ben-Natan et al., as applied to claims 23, 33 and 43 above, and further in view of Mueller (6,115,544).

As in claims 24, 34 and 44, Burrows and Ben-Natan disclose the method and system above. However, neither clearly discloses highlighting a portion of the CAD design associated with the failure. Mueller discloses a method and system for displaying error message, wherein the error will is highlighted (column 3: lines 31-34, column 4: lines 19-22 and 48-62).

It would have been obvious to a person skilled in the art at the time the invention was made to include highlighting a portion of the CAD design associated with the failure into the method and system taught by Burrows and Ben-Natan above. This would have been obvious because Burrows clearly teaches that the results of the analysis are returned to the user either in the form of textual or graphical information (column 4: lines 50-61), and Mueller clearly suggests that by highlighting the error allows the user to identify the error quicker and enhances they type of error that occurred (column 3: lines 31-34, column 4: lines 19-22 and 48-62).

As in claims 25, 35 and 45, Burrows, Ben-Natan and Mueller disclose the method and system above. Further, Burrows specifically discloses that the results of the analysis are returned to the user either in the form of textual or "graphical" information (column 4: lines 50-61), and Mueller discloses that errors can be distinguished by generating and displaying a graphical representation of a "stop sign" or "yield sign" (column 5: lines 30-45). However, neither Burrows nor Mueller specifically disclose generating and displaying a graphical representation of a light bulb.

It would have been obvious to a person skilled in the art at the time the invention was made to include generating and displaying a graphical representation of a light bulb into the

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method and system taught by Burrows, Ben-Natan and Mueller above. This would have been obvious because Mueller clearly teaches that graphical representations (or icons), which suggest or imply further meaning into what they represent (e.g., a stop sign for fatal errors) can be used (column 5: lines 30-45). This would have suggested to a person skilled in the art that other graphical representations (or icons) (e.g., a light bulb) could also be incorporated into the system taught by Mueller above and have a similar meaning without affecting the overall operation of Mueller.

Response to Arguments

11. Applicant's arguments with respect to claims 16-67 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott T Baderman whose telephone number is (703) 305-4644. The examiner can normally be reached on Monday-Friday, 6:45 AM-4:15 PM, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (703) 305-9713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott T Baderman
Primary Examiner
Art Unit 2113

STB